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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,159	12/01/2003	Erning Xia	P03366	4792

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EXAMINER

VANIK, DAVID L

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,159

Applicant(s)

XIA ET AL.

Examiner

David L. Vanik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 15-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13 and 14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Receipt is acknowledged of the applicant's Oath or Declaration filed on 12/30/2003. Receipt is also acknowledged of the applicant's Information Disclosure Statement filed on 11/12/2003.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-4, 8-12, 16-17, drawn to a composition comprising a saccharide and a cationic polysaccharide, classified in class 536, subclass 1.11+.
- II. Claims 13-14, drawn to a method of using a composition comprising a saccharide and a cationic polysaccharide, classified in class 424, subclass 427.
- III. Claims 5-7, 15, 18-19, drawn to a method of producing a composition comprising a saccharide and a cationic polysaccharide, classified in class 536, subclass 1.11+.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be

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shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, a composition comprising saccharide and a cationic polysaccharide can be used in a food-based product.

3. Inventions I and III are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, a composition comprising a saccharide and a cationic polysaccharide can be mixed together, with food preservatives, in an amount sufficient to create a food-based product.

4. Inventions II and III are unrelated to one another. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, a method of producing a product and a method of using a product have different functions and effects.

5. Searching the inventions of Groups I – III together would impose a search burden on the examiner. In the instant case, the search of a composition and a method of using and producing said composition would impose a search burden.

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6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. Because these inventions are distinct for the reasons given above and the search required for each subset of Groups I – III are not required for one another, restriction for examination purposes as indicated is proper.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. During a telephone conversation with Paul Lavoie on 7/8/2005 a provisional election was made without traverse to prosecute the invention of Group II, claims 13-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-12 and 15-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

Claims 13-14 are objected to because of the following informalities: Since the method claims 13-14 were elected, applicant needs to incorporate the limitations of claims 1 and 8 into claims 13-14. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 6,274,133 ('133).

'133 disclose a method for treating a contact lens with a solution (abstract). The method comprises contacting the surface of a contact lens with a solution comprising a cationic cellulose polymer, a tonicity agent, and a buffering agent (claim 1). Cellulose polymers are a well-known example of polysaccharides. According to '133, a wetting agent can be added to the contact lens solution (Claims 4-5). The wetting agent can comprise mono or

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disaccharides (claim 5). Thus, the contact lens solution advanced by '133 comprises a cationic polysaccharide and a saccharide. It should be noted that the examiner is interpreting a contact lens as a type of medical device.

It is the examiner's position that, inherently, the contact lens solution advanced by '133 would eliminate a "microbial burden" when soaked with the contact lens. Since the essential elements of the '133 composition are identical to the instant composition (that is, a contact solution comprising a cationic polysaccharide and a saccharide), the composition would inherently have the same physiochemical properties as the compositions set forth in the instant application. As such, it is the examiner's position that the composition advanced by '133 anticipates the compositions enumerated in the instant claim set.

The claims are therefore anticipated by US patent 6,274,133 ('133).

Claims 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,401,327 ('327) as evidenced by US 6,274,133 ('133).

'327 disclose a contact lens solution comprising a cationic polysaccharide, polymer JR-30M, and a saccharide, Glucam E-20 (Table 8, column 10, lines 27-38 and Table 10, column 11, lines 1-13). As evidenced by '133, glucam is an ethoxylated glucose (column 3, lines 1-3). Since glucose is a saccharide and glucam is an example of glucose, glucam is under the umbrella of the saccharide family. According to '327, the contact lens solution can be contacted with the lens for a sufficient time to disinfect said contact lens (column 6, lines 5-19). It

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should be noted that the examiner is interpreting a contact lens as a type of medical device.

The claims are therefore anticipated by US patent 6,274,133 ('133).

Claims 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 4,436,730 ('730).

'730 disclose contact lens solution comprising a cationic polysaccharide, polymer JR-400 or polymer JR-30M, together with a saccharide, hydroxyethyl cellulose (abstract and Examples 5-6). As applicant points out in the instant claim 4 and the instant specification on page 8, both polymer JR-400 and polymer JR-30M are cationic polysaccharides. Since the contact lens is soaked in the solution, it is the examiner's position that the surface of the contact lens is contacted with said solution (abstract and column 1, line 65 – column 2, line 6). It should be noted that the examiner is interpreting a contact lens to be a type of medical device.

It is the examiner's position that, inherently, the contact lens solution advanced by '730 would eliminate a "microbial burden" when soaked with the contact lens. Since the essential elements of the '730 composition are identical to the instant composition (that is, a contact solution comprising a cationic polysaccharide and a saccharide), the composition would inherently have the same physiochemical properties as the compositions set forth in the instant

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application. As such, it is the examiner's position that the composition advanced by '730 anticipates the compositions enumerated in the instant claim set.

The claims are therefore anticipated by US patent 4,436,730 ('730).

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Vanik whose telephone number is (571) 272-3104. The examiner can normally be reached on Monday-Friday 8:30 AM - 5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carlos Azpuru, can be reached at (571) 272-0588. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

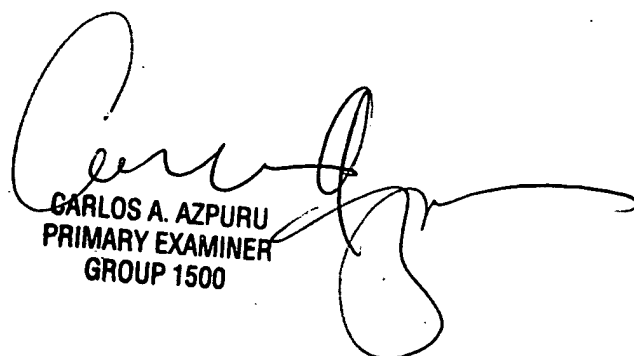
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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David Vanik, Ph.D.

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7/13/05


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PRIMARY EXAMINER
GROUP 1500